

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte E-TAO HUANG

Appeal No. 96-4017
Application 08/217,544¹

ON BRIEF

Before COHEN, FRANKFORT and STAAB, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed March 25, 1994.

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DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 1, which is the only claim remaining in the application. Claim 2 has been canceled.

Appellant's invention relates to an antitheft device for attachment to a vehicle steering wheel. A copy of independent claim 1, the sole claim on appeal, is attached to this decision.

The references of record relied upon by the examiner in a rejection of appealed claim 1 under 35 U.S.C. § 103 are:

Wang	5,092,146	Mar. 3, 1992
Lien	5,097,685	Mar. 24, 1992
Wu	5,255,544	Oct. 26, 1993

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Wu in view of Wang and Lien.

Rather than reiterate the examiner's explanation of the above-noted rejection and the conflicting viewpoints advanced by

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the examiner and appellant regarding that rejection, we make reference to the final rejection (Paper No. 6, mailed March 15,

1995), the examiner's answer (Paper No. 11, mailed November 14, 1995) and the supplemental examiner's answer (Paper No. 13, mailed April 1, 1996) for the examiner's reasoning in support of the rejection, and to appellant's brief (Paper No. 10, filed August 15, 1995) and reply brief (Paper No. 12, filed January 16, 1996) for appellant's arguments thereagainst.

OPINION

Before addressing the examiner's rejection, we note that the last clause of claim 1 on appeal appears to us to be somewhat unclear. Accordingly, we turn to the specification and drawings of the application in an effort to arrive at a proper understanding of this claim recitation. The claim language in question reads as follows

said body member being on the same surface of a steering wheel, not bending upward when the anti-theft device is attached to the steering wheel, preventing a rider from colliding with the elongated body member when entering the vehicle[.]

Viewing Figure 3 of the application drawings and the statements on page 1 of the specification (lines 18-23), we understand that a drawback of the prior art was that when the hook member on the elongate body member (F) was engaged with the steering wheel, the right-hand end of the body member, as seen in Figure 3, was canted at an angle towards the space within the vehicle to be occupied by a rider or passenger, thus making it "liable to collide with a rider coming in the car." To overcome this drawback, appellant provided the steering wheel antitheft device of the application (e.g., Figure 8) with a hook member (12) provided as an intermediate part of the body member (1) and so oriented that the body member (1) essentially aligns with the plane of the steering wheel (B) when the steering lock is attached to the steering wheel, thus significantly reducing any possibility that a rider or passenger entering the right side of the vehicle might collide with the right-hand end of the body member (1) and be injured. See appellant's specification, page 5, lines 7-15.

We understand the recitation in the last clause of claim 1 to be directed to this advantage of the claimed invention and construe it accordingly. Thus, for purposes of this appeal, the last clause of the claim is understood as --- said body member being substantially aligned with the plane of the steering wheel and not canted into the passenger carrying region when the antitheft device is attached to the steering wheel, thus preventing a rider from colliding with the elongated body member when entering the vehicle ---.²

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of this review, we have made the determination that the examiner's rejection of appealed claim 1 under 35 U.S.C. § 103 cannot be sustained. Our reasons follow.

² We, however, leave the exact wording of any clarifying amendment to the last clause of claim 1 to the examiner and appellant during any further prosecution of the application.

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The proper test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art. See Cable Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886-887 (Fed. Cir. 1985); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). The law followed by our court of review,

and thus by this Board, is that "[a] prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). A rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has

the initial duty of supplying the factual basis for the rejection he/she advances. The examiner may not, because he/she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d

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1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S.
1057 (1968).

In this case, essentially for the reasons stated by appellant in the brief (pages 4-8) and reply brief, we find that the examiner's rejection under 35 U.S.C. § 103 is not sustainable. Like appellant, we are of the opinion that the examiner has inappropriately relied upon hindsight and improperly used appellant's own disclosure and teachings as a guide through the

prior art references and the maze of individual features thereof in attempting to combine selected ones of those features in a modification of the Wu antitheft device so as to arrive at the claimed subject matter.

Moreover, even if the references were combined as urged by the examiner, we share appellant's view that the antitheft device defined in claim 1 on appeal would not have been the result, since the examiner's factual finding that Lien teaches or discloses "a rod member 5 having annular grooves with vertical

side walls 52 to receive a deadbolt," as urged in the final rejection (page 3) and in the answer (page 5), is in error. Appellant's claim 1 on appeal requires that the elongated rod member (3), which telescopes in the passageway (10) of the elongated body member (1), include a plurality of annular grooves (31) formed in a substantial portion of the rod member and that each of said annular grooves have opposite vertical side surfaces spaced apart from one another to enable the dead bolt (21) of the lock (2) to engage therein to hold the rod member immovable when the pusher (20) of the lock is pressed down. See particularly Figures 4, 6 and 7 of the application drawings. Like appellant (brief, page 6), we find no teaching or disclosure in Lien of

annular grooves having the claimed configuration, and thus consider that the examiner's assertions to the contrary are without foundation and based on pure speculation. There is simply no clear disclosure in Lien of the configuration of the grooves (52) and no reasonable suggestion that the grooves (52) have opposite vertical side surfaces spaced apart from one another, as required in claim 1 on appeal.

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Based on the foregoing, the decision of the examiner
rejecting claim 1 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
LAWRENCE J. STAAB)	
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APPENDED CLAIM

1. An antitheft device for attachment to a vehicle steering wheel comprising;

an elongated body member having an inner end portion and an outer end portion extending along a common control axis, and provided with: a passageway in the inner [end] portion; a lock housing fixed upright on the inner end portion and having an interior chamber communicating with said passageway; a first generally "U"-shaped hook having opposite leg portions, the leg portions having ends forming an opening therebetween for hooking a portion of a steering wheel whereby the inner end portion is attached to one leg portion and the outer end portion is attached to the opposite leg portion such that the opening extends obliquely to the elongated body member;

a lock fixed in said lock housing and having a round solid pusher to extend out of an upper end of the lock, a key hole formed in said pusher to rotate it 90 degrees for locking and unlocking, and a rod-shaped dead bolt extending down from a bottom end of the lock connected to and moving with the pusher;

an elongate rod member provided to telescope in said passageway having: a second U-shaped hook on an outer end for hooking a portion of a steering wheel; and a plurality of annular grooves formed in a substantial portion of the rod member, each of said annular grooves having opposite vertical side surfaces spaced apart from one another to enable said dead bolt to engage therein to hold said rod member immovable when said pusher of the lock is pressed down;

said body member being on the same surface of a steering wheel, not bending upward when the anti-theft device is attached to the steering wheel, preventing a rider from colliding with the elongated body member when entering the vehicle; [sic]